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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/943,511 10/06/97 DIAB

M MASIMO.007C2

QM12/0914

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EXAMINER

WINAKUR, F

ART UNIT

PAPER NUMBER

3736

DATE MAILED:

09/14/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
08/943,511

Applicant(s)

Diab et al.

Examiner

Eric Winakur

Group Art Unit

3736



☒ Responsive to communication(s) filed on October 16, 1998 and November 20, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 39-64 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 39-64 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. This action is responsive to the amendments filed October 16, 1998 and November 20, 1998. The entire Office Action of November 25, 1998 (Paper #4) is hereby withdrawn since the amendments were filed prior to the mailing of the Office Action. Applicant's response period will be reset to begin with the mailing of this supplemental action.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 39 - 44, 46, 47, 49, 50, 56 - 61, and 64 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not teach a processor that "tracks" portions of a signal in the presence of motion or determines a physiological parameter based upon "expectation" about the ranges and possible variation over time.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 39 - 44, 46, 47, 49, 50, 55, and 57 - 61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to claim 39, the phrase "said portions" (line 8) is inconsistent with its antecedent. With regard to claim 41, the term "said" should be

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inserted before “processor” (line 1). With regard to claim 42, the phrase “said portions” (line 8) is inconsistent with its antecedent. With regard to claims 46 and 49, the phrase “said portions” (line 2) is inconsistent with its antecedent. With regard to claims 47 and 50, the term “said” should be inserted before “processor” (line 1). With regard to claim 55, Applicant is requested to confirm that the phrase “a least means squares analysis” is correct. With regard to claim 57, it is unclear what provides basis for the phrase “based upon the confidence”.

6. Claims 48 - 50 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 45 - 47. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. Claims 39 - 56 and 62 - 64 are rejected under 35 U.S.C. 102(e) as being anticipated by Robinson et al. Robinson et al. teach a pulse oximeter apparatus (Figure 1) and method that includes generating a light spectrum including a plurality of wavelengths, detecting the light after interaction with a patient's tissue to obtain systolic and diastolic sets of intensity vs. wavelength measurements, and calculating a blood oxygen level using an algorithm and a calibration model. The algorithm is

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selected from a group including least squares and Kalman filtering analysis (column 14, line 55 - column 16, line 13). Robinson et al. further teach that their system can compensate for noise in the detected signal (column 25, line 15 - column 27, line 15).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Winakur whose telephone number is (703) 308 - 3940. The examiner can normally be reached on Monday - Thursday from 7:30 AM to 5:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cary O'Connor, can be reached on (703) 308- 2701. The fax phone number for this group is (703) 308 - 0758.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308 - 0858.

Eric F. Winakur  
Art Unit 3736  
January 31, 1999

